REMARKS

The present Amendment amends claims 1-37. Therefore, the present application has pending claims 1-37.

Information Disclosure Statement

The Examiner has refused to consider the English translation of the Korean Office Action filed with the November 1, 2004 Office Action, alleging that a copy was not included with the November 1, 2004 Office Action. Applicants are enclosing additional copies of the translation of the Korean Office Action and the Form PTO-1449 filed on November 1, 2004. Applicants are also enclosing a copy of the date stamped postcard acknowledging the Patent Office's receipt of an Information Disclosure Statement, Form PTO-1449 and copies of references on November 1, 2004. Applicants respectfully request that the Examiner return an initialed Form PTO-1449 acknowledging his consideration of the translation of the Korean Office Action with the next Patent Office communication.

35 USC §102 Rejections

Claims 34 and 35 stand rejected under 35 USC §102(b) as being anticipated by U.S. Patent No. 5,825,883 to Archibald, et al. ("Archibald"). This rejection is traversed for the following reasons. Applicants submit that the features of the present invention, as now more clearly recited in claims 34 and 35, are not taught or suggested by Archibald whether taken individually or in combination with any of the other references of record. Therefore, Applicants respectfully request the Examiner to reconsider and withdraw this rejection.

Amendments were made to the claims so as to more clearly describe the features of the present invention. Particularly, amendments were made to the claims to more clearly describe that the present invention is directed to a method for calculating a licensing fee of digital contents, as recited for example, in independent claims 34 and 35.

Claim 34

The present invention as recited in claim 34 provides a method of calculating a licensing fee of digital contents, including a step of counting the number of pages displaying digital contents. Another step of this method includes calculating a fee according to the number of displayed pages. The prior art does disclose all of these features.

The above described features of the present invention, as now more clearly recited in claim 34, are not taught or suggested by any of the references of record, particularly Archibald, whether taken individually or in combination with the other references.

Archibald discloses a method and apparatus that keeps track of the use of digital applications on an as used basis. In this way, a publisher may be compensated for each use of its digital application rather than by a lump sum purchase price. Archibald's method and apparatus maintains a user payment database 100 (Fig. 3). The user payment database 100 includes a plurality of records for users 106 and 108. Within each user record is a plurality of publisher records 110 and 112, and within each publisher record 110 and 112 is an application

identification field 114, a price field 116, a use unit field 118, an amount used field 120, and an amount owed field 122. As illustrated in Fig. 3, user #1 (item 152) acquired two programs (programs 1 and 2) from publisher #1 (item 110). Publisher # 1 has established that, for this user, program 1 costs 10 cents per unit of use, where the unit of use is 5 minutes. The user used the program for 60 minutes, which results in 12 units of use. Therefore, the amount owed to the publisher is $1.20. (See generally, column 7, lines 32-67).

The method for calculating a licensing fee as recited in claim 34 includes the steps of counting the number of pages displaying digital contents, and calculating a fee according to the number of displayed pages. Archibald does not disclose these steps. Archibald discloses calculating a fee according to usage based on time or time increments. Alternatively, "usage or consumption, may be based on any one or a combination of several different use criterion, such as time, time increments, functionality, resource, number of accesses or invocations, [and] amount of database access" (column 8, lines 38-56). None of the bases of use disclosed in Archibald include the number of displayed pages, as claimed. The Examiner suggests that usage based on the "number of accesses or invocations" is the same as the number of displayed pages. However, Applicants disagree. Contrary to the Examiner's assertions, Archibald does not disclose calculating a fee based on the number of pages displaying digital contents.

Therefore, Archibald fails to teach or suggest "counting the number of pages displaying digital contents; and calculating a fee according to the number of displayed pages" as recited in claim 34.

Claim 35

The present invention as provided in claim 35 provides a method for calculating a licensing fee of digital contents, including the steps of counting a display time during which digital contents are displayed, and calculating a fee in accordance with the display time. The method also includes a step of increasing an amount of the digital contents if a predetermined set of parameters is exceeded. Archibald does not disclose all of these features.

The above described features of the present invention, as now more clearly recited in claim 35, are not taught or suggested by any of the references of record, particularly Archibald, whether taken individually or in combination with the other references.

One feature of the present invention includes increasing an amount of the digital contents if a predetermined set of parameters is exceeded. Archibald does not teach or suggest this feature. Archibald discloses a method and apparatus that keeps track of the use of digital applications on an as used basis. The Archibald method and apparatus does not increase the amount of digital contents, in the manner claimed.

Therefore, Archibald fails to teach or suggest "increasing the amount of digital contents if a predetermined set of parameters is exceeded" as recited in claim 35.

Therefore, Archibald fails to teach or suggest the features of the present invention, as now more clearly recited in the claims. Accordingly, reconsideration and withdrawal of the 35 USC §102(b) rejection of claims 34 and 35 is respectfully requested.

The remaining references of record have been studied. Applicants submit that they do not supply any of the deficiencies noted above with respect to the references used in the rejection of claims 34 and 35.

35 USC §103 Rejections

Claims 1-33, 36 and 37 stand rejected under 35 USC §103(a) as being unpatentable over Archibald. This rejection is traversed for the following reasons. Applicants submit that the features of the present invention, as now more clearly recited in claims 1-33, 36 and 37, are not taught or suggested by Archibald, whether taken individually or in combination with any of the other references of record. Therefore, Applicants respectfully request the Examiner to reconsider and withdraw this rejection.

Amendments were made to the claims so as to more clearly describe features of the present invention. Specifically, the claims were amended to more clearly describe that the present invention is directed to a method for calculating a licensing fee of digital contents, a system for calculating a licensing fee of digital contents, and a computer readable recording medium storing a program for calculating a licensing fee of digital contents, as recited for example, in independent claims 1, 36 and 37.

Claims 1, 33, 36, and 37

The present invention, as recited in claim 1, and as similarly recited in claims 33, 36 and 37, provides a method, system and program for calculating a licensing fee of digital contents, where the method includes a step of distributing digital contents from a center side distribution apparatus to a terminal apparatus via a shop side distribution apparatus. The present invention also provides the steps of allowing digital contents to be viewed and listened to during a limited time period and collecting an audiovisual fee based on the length of the limited time period. Furthermore, the present invention provides the steps of calculating an amount of digital contents viewed and listened to at the terminal apparatus and calculating a copyright fee based on the calculated amount of digital contents viewed and listened to. The prior art does not disclose all of these features.

As previously discussed, Archibald discloses a method and apparatus that keeps track of the use of digital applications on an as used basis. In the Office Action, the Examiner concedes that Archibald fails to expressly disclose all of the features of the present invention. Nonetheless, the Examiner asserts that the features not disclosed in Archibald would be obvious. Applicants disagree.

The Examiner concedes that Archibald fails to expressly disclose where the digital contents are distributed via a shop side distribution apparatus, as recited in claims 1, 36 and 37. However, the Examiner asserts that this feature would be obvious. The Examiner provides no motivation as to why this feature would be obvious (see paragraph 9 of the Office Action, which merely states that "Archibald

does disclose distributing digital applications through several channels"). As discussed in MPEP §2143.01, there must be some suggestion or motivation to modify the reference teachings. Also, although a prior art device "may be capable of being modified to run in the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so" (see *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990)). As such, there is a lack of suggestion or motivation to modify Archibald to such that the digital contents are distributed via a shop side distribution apparatus, in the manner claimed.

The Examiner also concedes that Archibald fails to expressly disclose where the digital contents are distributed within a limited time period, as recited in claims 1, 33, 36 and 37. However, the Examiner asserts that it would have been obvious to modify Archibald's metered use "to allow better control of released content and allow better distribution of newer releases." Applicants submit that the Examiner is improperly relying upon hindsight reasoning. Archibald's method and apparatus measures the amount of use of a digital application, so as to compensate a publisher based on the use. The object of the Archibald's invention is to substantially eliminate the problems of piracy "by de-emphasizing control of distribution and focusing on use of a digital application, such as a software application" (column 2, lines 44-47). As such, Archibald does not limit the use of a digital application, but rather provides unlimited use to a user. In this way, Archibald teaches away from distributing digital contents within a limited time period, in the manner claimed. Furthermore, and contrary to the Examiner's assertions, one would not be motivated "to allow better

control of released content" in a method and apparatus that has a goal of "de-emphasizing control of distribution".

Therefore, Archibald fails to teach or suggest "a step of distributing digital contents from a center side distribution apparatus to a terminal apparatus via a shop side distribution apparatus" as recited in claims 1, 36 and 37.

Therefore, Archibald fails to teach or suggest "a step of allowing digital contents capable of being accessed at a limited place to be viewed and listened to during a limited time period" and "a step of collecting an audiovisual fee according to the length of said limited time period" as recited in claim 1, and as similarly recited in claims 33, 36 and 37.

Claims 2-32

Claims 2-32 stand rejected under 35 USC §103(a) as being unpatentable over Archibald. Applicants submit that Claims 2-32 are dependent on claim 1, and therefore, are patentable for at least the same reasons discussed previously regarding independent claim 1.

Claims 9-16 and the Examiner's Official Notice

Further regarding claims 9-16, the present invention as recited in those claims provides a step of prolonging an audiovisual time of digital contents if an electronic advertisement is viewed and listened to at the terminal apparatus. The Examiner concedes that Archibald does not disclose this feature. However, the Examiner gives Official Notice that "compensating users for viewing advertisements was well known to one of ordinary skill at the time the invention was made; and it would have

been obvious to compensate the user with incentives related to receiving digital content" (see paragraph 16 of the Office Action). Applicants traverse this finding, and submit that a step of prolonging an audiovisual time of digital contents if an electronic advertisement is viewed and listened to at the terminal apparatus, in a method as claimed, is not well known in the art.

If Official Notice is taken of a fact, and is unsupported by documentary evidence, the technical line of reasoning underlying the Examiner's decision to take such notice must be clear and unmistakable. Applicants submit that it is not clear and unmistakable that one would be motivated to modify Archibald so as to prolong an audiovisual time of digital contents if an electronic advertisement is viewed and listened to at a terminal apparatus, in the manner claimed. (See *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001) (holding that general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection)).

Therefore, Archibald fails to teach or suggest "a step of prolonging an audiovisual time of digital contents if an electronic advertisement is viewed and listened to at the terminal apparatus capable of viewing and listening to the digital contents" as recited in dependent claims 9-16.

Therefore, Archibald fails to teach or suggest the features of the present invention, as now more clearly recited in the claims. Accordingly, reconsideration

and withdrawal of the 35 USC §103(a) rejection of claims 1-33, 36, and 37 is respectfully requested.

The remaining references of record have been studied. Applicants submit that they do not supply any of the deficiencies noted above with respect to the references used in the rejection of claims 1-37.

In view of the foregoing amendments and remarks, Applicants submit that claims 1-37 are in condition for allowance. Accordingly, early allowance of claims 1-37 is respectfully requested.

To the extent necessary, Applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, or credit any overpayment of fees, to the deposit account of Mattingly, Stanger, Malur & Brundidge, P.C., Deposit Account No. 50-1417 (referencing attorney docket no. 500.40470X00).

Respectfully submitted,

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